

support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 1 recites a method of accessing instant messaging from a telephone comprising the step of presenting to a telephone user a subset of a predetermined user list, the subset representing users logged onto a data network; responsive to the telephone user selecting a particular user from the subset of the predetermined user list, sending a message from the telephone user to the selected data network user using an instant messaging protocol.

Neither Sekiguchi or DeSimone, alone or in combination, teach or suggest a method of accessing instant messaging from a telephone that includes selecting a particular user, as is recited in claim 1. The text of Sekiguchi (col. 11, line 43) that is cited by the Office action refers to selecting a "meeting room," not a particular user. More specifically, Sekiguchi states that "[l]istening to such a message, the user D selects a meeting room he or she wants to participate. Specifically, if the meeting room the user D wants to access is the theme ski "ski (ABC ski resort)" to which users A through C have already accessed, the user D dials the number corresponding to the meeting room" (col. 11, lines 39-44) (emphasis added).

Nowhere does the cited text teach or suggest selecting a particular one of the users. Accordingly, the combined art fails to meet the standard presented by MPEP § 2143, which requires that the cited references must teach or suggest all the claim limitations to establish a prima facie case of obviousness. Therefore, claim 1 is deemed allowable for at least this reason. Claims 2-21 depend from and further limit claim 1 and are allowable for at least this reason.

Claim 22 recites a similar limitation and is allowable for at least the same reason as stated above with respect to claim 1. Claims 23-32 depend from and further limit claim 22 and are allowable for at least this reason.

Claim 33 recites identifying a subscriber, a telephone number at which they can receive messages, and a period of time for which they can receive messages at this number; establishing the user's presence and ability to receive instant messages on the data network during the specified time period; where an instant message is sent to the

subscriber during this period of availability, calling the subscriber at the predetermined telephone number and delivering the message.

Neither Sekiguchi or DeSimone, alone or in combination, teach or suggest identifying a period of time for which they can receive messages at a number or establishing the user's presence and ability to receive instant messages on the data network during the specified time period, as is recited in claim 33. The Office action acknowledges that Sekiguchi fails to disclose a period of time for which they can receive messages, and relies on col. 2, lines 13-24 of DeSimone.

The cited text of DeSimone states "[w]hile the foregoing and other features of e-mail, chat and instant messaging have proven very useful in a number of contexts, these systems suffer from a number of real time limitations. For example, current chat environments limit users to participation in only one multiple-party (three or more participant) real-time chat room at a time. Users may participate in more than one conversation in real time, if these are two-way conversations. Likewise, a user may pursue multiple conversations (strings of messages) with multiple users, but only over an elapsed time period using multiple windows for conversation events, participation, and display." The cited text appears to be referring to the requirement that, while a user may pursue multiple conversations, the conversations cannot be simultaneous (e.g., they can occur only over an "elapsed time period"). This has nothing to do with identifying a period of time for which a user can receive messages at a number or establishing the user's presence and ability to receive instant messages on the data network during the specified time period, as is recited in claim 33. Accordingly, the hypothetical combination of the cited references would not achieve applicant's claimed invention. The rejection is properly withdrawn in that the cited references do not teach or suggest all the claim limitations to establish a prima facie case of obviousness. MPEP § 2143. Therefore, claim 33 is deemed allowable for at least this reason.

Claim 34 recites a similar limitation and is allowable for at least the same reason as stated above with respect to claim 33. Claims 35-54 depend from and further limit claim 34 and are allowable for at least this reason.

2. No Basis in Cited References for Combining References and so Rejection is Properly Withdrawn.

In view of the above, Applicant further respectfully submits that the combination of Sekiguchi and DeSimone is improper and cannot be used to reject independent claims 1, 22, 33, and 34. MPEP § 2143.01 states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Furthermore, according to MPEP §2143, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Also, rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Here, there is no teaching, suggestion, or motivation to support the combination of Sekiguchi and DeSimone.

The case law recites that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the cited references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *Id.* It is respectfully submitted that the only way Sekiguchi and DeSimone could be pieced together to defeat patentability is indeed to use Applicant’s disclosure as a blueprint.

Accordingly, Applicant submits that independent claims 1, 22, 33, and 34 are allowable. Claims 2-21, 23-32, and 35-54 depend from and further limit their respective independent claim and are allowable over the cited references for at least this reason.

Conclusion

It is respectfully submitted that independent claims 1, 22, 33, and 34 are in condition for allowance. Dependent claims 2-21, 23-32, and 35-54 depend from and further limit their respective independent claims and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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